

### REMARKS

The Office Action mailed December 30, 2004, has been received and its contents carefully noted. Original claims 1-15 and new claims 16-28 are pending in the application.

#### **Defective Reissue Declaration**

In the Office Action, the Examiner indicates in ¶ 2, that the declaration filed with the reissue application is defective because it fails to contain a statement that “all errors which are being corrected in the reissue application up to the time of filing of the oath, arose without and deceptive intent on the part of the Applicant”. Applicant respectfully objects to the Examiner’s finding.

Applicant filed the reissue oath using PTO Form SB/52. Applicant directs the Examiner’s attention to the top of page 2 of the declaration form. In the box entitled “At least one error upon which the reissue is based is described as follows:” at the bottom of the box, after Applicant’s “See Attached Sheet,” the sentence printed at the bottom of the box clearly states: “All errors corrected in this reissue application arose without any deceptive intention on the part of the applicant.” The undersigned counsel respectfully submits that Applicant’s signature on Form SB/52 has the legal effect of containing the alleged omitted statement.

The Examiner rejected claims 1-28 under 35 U.S.C. § 251, as being based on a defective reissue declaration. Applicant respectfully traverses this rejection as moot in view of the remarks in the above paragraph, and requests withdrawal of this rejection.

With regard to the Examiner’s comments about the listing of all pending claims under 37 C.F.R. §1.173(c), Applicant has complied with the requirements, and filed a complete listing of all pending claims beginning at page 2 of this paper.

### **New Matter Rejection**

The Examiner has rejected claims 16-28 under 35 U.S.C. § 251 as being based upon new matter in the form of newly added compositions for which reissue is sought. The Examiner contends that the claimed compositions are not supported by the specification of the prior patent as there is no description of a composition that does not include a plasticizer. Applicant respectfully traverses this rejection.

More specifically, the Examiner is rejecting claims 16-28 based on an erroneous understanding of the reissue statute, 35 U.S.C §251. The Examiner stated in page 4 of the Office Action, “The proper test as to whether reissue claims are for the same invention as that disclosed as being the invention in the original patent is ‘an essentially factual inquiry confined to the objective intent manifested by the original patent.’ *In re Amos*, 953 F.2d 613, 618 (Fed. Cir. 1991)...”(emphasis added). Applicant respectfully suggests that the Examiner has misapplied the holding of *Amos*. The Examiner’s attention is invited to the later decided case of *Hester v. Stein*, 142 F.3d 1472; 46 USPQ2d 1641 (Fed. Cir. 1998). In *Hester*, the lower court held reissue claims invalid because the claims, *inter alia*, “...did not meet the objective intent of the original patent clause of §251...”. The Federal Circuit reversed the holding of the lower court, stating that the “objective intent” standard of §251 was addressed “squarely in *Amos*.” The *Amos* court held that §251 does not include a separate requirement of an objective intent to claim. See *Amos*, 953 F.2d at 618-19; 21 USPQ2d at 1275-76. The Federal Circuit concluded that the essential inquiry was ‘whether one skilled in the art, reading the specification, would identify the subject matter of the new claims as invented and disclosed by the patentees’. *Hester*, 142 F.3d at 1484-1485; (aff’d. on other grounds).

All of the elements of the rejected claims are taught in the original specification, and one of skill in the art would identify those elements as invented and disclosed by Applicant. The specification includes detailed descriptions of using the cycloalkyl methacrylate copolymer and

the various evaporative solvents in conjunction with making the wound care dressing of the present invention. One of ordinary skill would understand that the function of the omitted plasticizer is as an additive to enhance the properties which exist in the copolymer as part of the composition. One of ordinary skill would also understand that one does not always have to use polymer additives if the sought after properties are found without their addition.

Further, the Examiner's rejections are confining the scope of Applicant's original disclosure to a preferred embodiment. Such limitations are in error. *See, In re Kenneth D. Peters*, 723 F.2d 891, 221 USPQ 952 (Fed. Cir. 1983)(*hereinafter* "Peters").

In *Peters*, the applicant had claimed a flat panel display device having, *inter alia*, metal tips as part of the structure, and the tip was defined in the claim in one particular shape. Peters filed a reissue claiming other tip shapes. The Examiner and the Board rejected the claims under §251 and §112 as unsupported by Peters' original disclosure. The Federal Circuit reversed the Board, stating that the Board erroneously held Peters to the specific embodiment disclosed in his original patent (citing *In re Rasmussen*, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981)). In particular, the Federal Circuit held that:

"the broadened claims merely omit an unnecessary limitation that restricted one element of the invention to the exact and non-critical shape disclosed in the original patent. In sum, nothing in the original disclosure indicates or suggests that the tapered shape of the tips was essential or critical to either operation or patentability of the invention. Indeed, if the reissue claims had been submitted with the original application, it is difficult to perceive how they could have been properly rejected under §112." *Peters* at 893-4.

The same situation exists with the outstanding rejections of the claims in the present invention. The plasticizer disclosed in the original claims is merely a limitation of the copolymer element

of the claimed invention. Applicant determined that the plasticizer was not essential or critical for the operability or patentability of the invention and filed this reissue application with broader claims as was his right to do so under §251. Moreover, as in *Peters*, there was neither a rejection made, nor art cited in the prosecution of the original patent, that caused the plasticizer limitation to be added to the original claims. Hence, there is no attempt by Applicant to recapture claims lost during prosecution.

Furthermore, also as in *Peters*, nowhere in the specification of the original patent does Applicant state that the plasticizer is critical to the operability of the claimed invention, and the specification would not indicate to one of ordinary skill in the art that the present invention, as presently claimed, would be inoperable without such an additive. The new claims presented in this reissue application are proof of this fact.

Finally, as Judge Markey stated in *Peters*, had the present Applicant submitted the rejected claims in the original application, it would be hard to conceive that claims 16-28 could have been rejected under §112. Certainly a written description that discloses and supports three elements in a claimed composition, supports less than all three in a second claimed composition, absent some teaching or art to the contrary. Applicant therefore respectfully requests withdrawal of this rejection.

Rejection under 35 U.S.C. §112, first paragraph

The Examiner rejected claims 16-28 under 35 U.S.C. §112, first paragraph, for failing to comply with the written description requirement. The Examiner asserts that claims 16-28 contain subject matter which was not described in the specification in such a way as to reasonably convey to one of ordinary skill in the art, that at the time the original application was filed, Applicant had possession of the claimed invention. The Examiner contends that the specification only is enabling for compositions which contain plasticizers and that it does not

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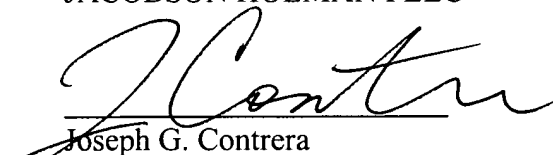
enable one of skill in the art to make and use a composition that does not include plasticizers.  
Applicant respectfully traverses this rejection.

Applicant submits that the grounds of rejection set forth under 35 U.S.C. §112, first paragraph, are overcome for the same reasons as set forth by Applicant in overcoming the rejections under §251 above, and therefore withdrawal of the rejection is respectfully requested.

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all currently outstanding rejections, and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned attorney at the number provided.

Respectfully submitted,

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Enclosure